

JAN 05 2007

PATENT
Docket No. 275.0003 0103IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): LI et al.)	Group Art Unit:	1635
)		
Serial No.: 10/772,661)	Examiner:	Tracy Ann Vivlemore
Confirmation No.:5608)		
)		
Filed: February 5, 2004)		
)		

For: COMPOSITION AND METHOD FOR *IN VIVO* AND *IN VITRO* ATTENUATION OF
GENE EXPRESSION USING DOUBLE STRANDED RNA

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2. 1449 FORMS (31 PGS)

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Mueting, Raasch & Gebhardt, P.A.
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By: David L. Provence
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Date: January 5, 2007
Signature: Sandy Truehart
Name: Sandy Truehart

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PATENT
Docket No. 275.00030103IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Li et al.) Group Art Unit: 1635
)
Serial No.: 10/772,661) Examiner: Tracy Ann Vivlemore
Confirmation No.: 5608)
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Filed: February 5, 2004)
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For: COMPOSITION AND METHOD FOR IN VIVO AND IN VITRO
ATTENUATION OF GENE EXPRESSION USING DOUBLE STRANDED
RNA

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the continuing duty of candor and good faith that is to be demonstrated before the United States Patent and Trademark Office (USPTO), enclosed are copies of documents which Applicants bring to the Examiner's attention as possibly being of interest in connection with the above-identified patent application. Per M.P.E.P. § 609, the information cited in the present Information Disclosure Statement shall not be construed to be an admission that the information is, or is considered to be, material to patentability. Consideration of the documents listed on the attached 1449 form are respectfully requested. Pursuant to the provisions of MPEP §609, Applicants further request that a copy of the 1449 form, marked as being considered and initialed by the Examiner, be returned with the next Official Communication.

Applicants would also like to bring to the Examiner's attention Benitec v. Nucleonics Civil Action No. 04-CV-0174 (JJF) in the U.S. District Court for the District of Delaware. Certain documents cited herein were first brought to the Applicants' attention in a search of literature related to this action.

Supplemental Information Disclosure Statement

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Applicant(s): LI et al.

Serial No.: 10/772,661

Confirmation No.: 5608

Filed: February 5, 2004

For: ***COMPOSITION AND METHOD FOR IN VIVO AND IN VITRO ATTENUATION OF GENE EXPRESSION USING DOUBLE STRANDED RNA***

Should the Examiner wish to review any documents in Applicants' possession related to this action, the Examiner is invited to contact the undersigned and any documents requested will be forwarded.

Documents U.S. Patent 5,578,716, WO 94/01550A1, Barlow et al., Beretta et al., Billy et al., Brand et al., Brummelkamp et al. (*Cancer Cell*, 2:243-247, (2002)), Burke et al., Haggarty et al., Harada et al., Kirchhoff et al., McManus et al. (*RNA*, 8:842-850 (2002)), Thoemis et al., listed on the attached Form PTO-1449 were cited in an Opposition of EP 1230375 B1.

Documents U.S. 5,631,148 (Urdea), and WO 99/32619 A1, of record, were also cited in the opposition.

Documents WO 95/27783 A1, WO 97/34638 A1, and Schaefer et al., listed on the attached Form PTO-1449 were cited in a foreign search or examination report corresponding to Korean application serial no. 10-2001-7013385 and mailed on August 8, 2006. This application has inventors in common with the instant application.

An English translation of non-English document, Zakharyan et al., is attached to the document. U.S. Patent 5,798,265 is being submitted as an English language equivalent of non-English document, EP 0 560 156 A2. An English abstract of non-English publications WO 92/19732 A1, WO 95/18223 A1, and WO 98/05770 A2, may be found on the cover page of the publication. An English abstract of non-English publications JP 09-110894 A and JP 09-227413 may be found attached to the publication.

This application is a continuation of U.S. Patent Application Serial No. 10/038,984, filed January 4, 2002, which is a continuation of U.S. Patent Application Serial No. 09/493,301, filed January 28, 2000 (Abandoned). In accordance with 37 C.F.R. §1.98(d), copies of documents previously cited by or submitted to the U.S. Patent and Trademark Office in connection with Applicants' prior application(s) listed above, are not included herewith.

Supplemental Information Disclosure Statement

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Applicant(s): LI et al.

Serial No.: 10/772,661

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Since this Information Disclosure Statement is submitted after the receipt of an Office Action in the above-identified patent application, please charge the fee of \$180 under 37 C.F.R. §§1.97(c) and 1.17(p), and any additional fees or credit any overpayment to Deposit Account No. 13-4895.

When the Examiner takes up the present application, consideration of these documents is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the below-listed telephone number, if they can be of any assistance during prosecution of the present application.

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on this 5 day of JAN., 2007, at 3:45 pm (Central Time).

Name: Sandy Truehart
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Respectfully submitted for

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Direct Dial (612)305-1005

JAN 05 2007

INFORMATION DISCLOSURE CITATION (Use several sheets if necessary)			Attorney Docket No. 275.00030103	Application No. 10/722,661			
			Applicants: Li <i>et al.</i> Information Disclosure Statement Mailed : PAGE 1 of 31 January 5, 2007				
PTO Form 1449			Filing Date: February 5, 2004		Group Art Unit: 1635		
U.S. PATENT DOCUMENTS							
Initial	Copy Enclosed	Document No.	Date	Name	Class	Sub-Class	Filing Date
		US 2002/0086356 A1	07/04/2002	Tuschl <i>et al.</i>			
		US 2002/0168707 A1	11/14/2002	Graham			
		US 2003/0018993 A1	01/23/2003	Gunterson <i>et al.</i>			
		US 2003/0036197 A1	02/20/2003	Glassman <i>et al.</i>			
		US 2003/0061626 A1	03/27/2003	Plactinck <i>et al.</i>			
		US 2003/0074684 A1	04/17/2003	Graham <i>et al.</i>			
		US 2003/0159161 A1	08/21/2003	Graham <i>et al.</i>			
		US 2003/0165894 A1	09/04/2003	Waterhouse <i>et al.</i>			
		US 2004/0022748 A1	02/05/2004	Ananthapadmanabhan <i>et al.</i>			
		US 2004/0064842 A1	04/01/2004	Graham <i>et al.</i>			
		US 2004/0138168 A1	07/15/2004	Satishchandran <i>et al.</i>			
		US 2004/0180439 A1	09/16/2004	Graham <i>et al.</i>			
		US 2004/0237145 A1	11/25/2004	Graham <i>et al.</i>			
		US 2004/0266005 A1	12/30/2004	Graham <i>et al.</i>			
		US 2005/0250208 A1	11/10/2005	Graham <i>et al.</i>			
		US 2006/0014715 A1	01/19/2006	Graham <i>et al.</i>			
		US 3,931,397	01/06/1976	Harnden			
		US 4,130,641	12/19/1978	Ts'o <i>et al.</i>			
		US 4,283,393	08/11/1981	Field <i>et al.</i>			
		US 4,469,863	09/04/1984	Ts'o <i>et al.</i>			
		US 4,605,394	08/12/1986	Skurkovich			
		US 4,766,072	08/23/1988	Jendrisak <i>et al.</i>			
		US 5,024,938	06/18/1991	Nozaki <i>et al.</i>			
		US 5,034,323	07/23/1991	Jorgensen <i>et al.</i>			
		US 5,173,410	12/22/1992	Ahlquist			
		US 5,190,931	03/02/1993	Inouye			
		US 5,208,149	05/04/1993	Inouye			
		US 5,231,020	07/27/1993	Jorgensen <i>et al.</i>			
		US 5,272,065	12/21/1993	Inouye <i>et al.</i>			
		US 5,365,015	11/15/1994	Grierson <i>et al.</i>			
		US 5,453,566	09/26/1995	Shewmaker <i>et al.</i>			
		US 5,514,546	05/07/1996	Kool			
		US 5,578,716	11/26/1996	Szyf <i>et al.</i>			
		US 5,643,762	07/01/1997	Ohshima <i>et al.</i>			
		US 5,683,985	11/04/1997	Chu <i>et al.</i>			
Examiner		Date Considered					
Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

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INFORMATION DISCLOSURE CITATION (Use several sheets if necessary) PTO Form 1449			Attorney Docket No. 275.00030103	Application No. 10/722,661			
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U.S. PATENT DOCUMENTS							
Initial	Copy Enclosed	Document No.	Date	Name	Class	Sub-Class	Filing Date
		US 5,686,649	11/11/1997	Chua <i>et al.</i>			
		US 5,691,140	11/25/1997	Noren <i>et al.</i>			
		US 5,693,773	12/02/1997	Kandimalla <i>et al.</i>			
		US 5,714,323	02/03/1998	Oshima <i>et al.</i>			
		US 5,739,309	04/14/1998	Dattagupta <i>et al.</i>			
		US 5,747,338	05/05/1998	Gicse <i>et al.</i>			
		US 5,795,715	08/18/1998	Livache <i>et al.</i>			
		US 5,798,265	08/25/1998	Springer <i>et al.</i>			
		US 5,808,036	09/15/1998	Kool			
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		US 5,850,026	12/15/1998	DeBonte <i>et al.</i>			
		US 5,874,555	02/23/1999	Dervan <i>et al.</i>			
		US 5,908,779	06/01/1999	Carmichael <i>et al.</i>			
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		US 6,010,908	01/04/2000	Grueuer <i>et al.</i>			
		US 6,022,863	02/08/2000	Peyman			
		US 6,054,299	04/25/2000	Conrad			
		US 6,133,024	10/17/2000	Helcne <i>et al.</i>			
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		US 6,369,038	04/09/2002	Blumenfeld <i>et al.</i>			
		US 6,372,965	04/16/2002	Lightner <i>et al.</i>			
		US 6,423,885	07/23/2002	Waterhouse <i>et al.</i>			
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		US 6,635,805	10/21/2003	Baulcombe <i>et al.</i>			
		US 69/646,807	Not Published	Graham <i>et al.</i>			
		US 60/117,635	Not Published	Li <i>et al.</i>			
		US 60/130,377	Not Published	Pachuk <i>et al.</i>			
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FOREIGN PATENT DOCUMENTS							
Initial	Copy Enclosed	Document No.	Date	Country	Class	Sub-Class	Translation
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		EP 0 306 347 B1	05/10/1995	Europe			
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		EP 0 350 151 A3	10/03/1990	Europe			
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FOREIGN PATENT DOCUMENTS							
Initial	Copy Enclosed	Document No.	Date	Country	Class	Sub-Class	Translation
		EP 0 560 156 A2	09/15/1993	Europe			No
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		EP 0 983 370 A1	03/08/2000	Europc			
		EP 0 983 370 B1	09/17/2003	Europe			
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		WO 95/03406 A3	09/14/1995	WIPO			
		WO 95/10607 A1	04/20/1995	WIPO			
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		WO 95/35706 A1	11/14/1996	WIPO			
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		WO 97/01952 A1	01/23/1997	WIPO			
		WO 97/07668 A1	03/06/1997	WIPO			
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PTO Form 1449		Filing Date: February 5, 2004	Group Art Unit: 1635
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)			
Initial	Copy Enclosed		
		"somatic cell," on-line medical dictionary, http://cancerweb.ncl.ac.uk/cgi-bin/ (January 2006).	
		Agrawal <i>et al.</i> , "RNA Interference: Biology, Mechanism, and Applications" <i>Microb. Mol. Biol. Rev.</i> 67:657-685 (2003).	
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		Anderson, "Human gene therapy," <i>Nature</i> 392:25-30 (1998).	
		Annex A filed in EP 99 910 039.9.	
		Annex B filed in EP 99 910 039.9 (September 9, 2005).	
		Annex C filed in EP 99 910 039.9 (September 9, 2005).	
		Annex D filed in EP 99 910 039.9 (September 9, 2005).	
		Appeal against decision to refuse a European patent application issued July 11, 2005, filed in EP 99 910 039.9 (September 9, 2005).	
Examiner		Date Considered	
Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.			

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PTO Form 1449		Filing Date: February 5, 2004	Group Art Unit: 1635
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)			
Initial	Copy Enclosed		
		Author unknown, "Breakthrough of the Year #4: Still hot," <i>Science</i> 302:2038-2045 (2003).	
		Bahner <i>et al.</i> , "Transduction of Human CD34 ⁺ Hematopoietic Progenitor Cells by a Retroviral Vector Expressing an RRE Decoy Inhibits Human Immunodeficiency Virus Type I Replication in Myelomonocytic Cells Produced in Long-Term Culture," <i>J. Virol.</i> 70:4352-4360 (1996).	
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		Baulcombe, "RNA as a target and an initiator of post-transcriptional gene silencing in transgenic plants," <i>Plant Molecular Biology</i> 32(1-2):79-88 (1996).	
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